



UNITED STATES PATENT AND TRADEMARK OFFICE  
Docket No. 15-IS-5295 (MHM Docket No. 12526US01)

In the Application of:

Grant, et al.

Serial No.: 09/468,155

Filed: December 21, 1999

For: ENTERPRISE-WIDE DATA ACCESS  
TECHNIQUES

Examiner: Patel, Shefali D.

Group Art Unit: 2621

Confirmation No.: 3289

**2<sup>nd</sup> PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal. **No fee is believed due with respect to the Notice of Appeal because the Applicants previously paid the fee. See MPEP § 1207.04.**

The review is requested for the reasons stated on the attached sheets

Respectfully submitted,

Date: April 11, 2006

By: \_\_\_\_\_

Joseph M. Butscher  
Reg. No. 48,326  
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.  
500 West Madison Street, 34th Floor  
Chicago, Illinois 60661  
Telephone: (312) 775-8000  
Facsimile: (312) 775 - 8100

## REMARKS

Claims 1-20 are currently pending in the present application. Claims 1-4, 6-12, and 14-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,424,996 (“Killcommons”) in view of United States Patent No. 6,317,743 (“Heck”). Claims 5 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Killcommons in view of Heck and Computer Dictionary, Third Edition, Microsoft Press, 1997, page 462. The Applicants respectfully traverse these rejections at least for the reasons discussed previously during prosecution and the following:

As an initial matter, the Applicants filed a first Pre Appeal Brief Request for Review, along with a Notice of Appeal (and fee), on November 30, 2005. After consideration of the Pre Appeal Brief Request for Review, the Panel reopened prosecution. *See* January 13, 2006 Notice of Panel Decision from Pre-Appeal Brief Review.

Once prosecution was reopened, the Examiner merely conceded that the finality of the previous rejection was improper. *See* March 13, 2006 Office Action at page 2. The Examiner, however, issued essentially the exact same office action as the one considered by the Panel. *See id.* (“Because of the improper decision of finality, a non-final action is being mailed out **with the same rejection.**”). In order to expedite prosecution of the present application, the Applicants have filed the current Request for Panel review and respectfully request that the Panel allow the rejected claims.

### **I. The Combination Of Killcommons And Heck Does Not Render The Pending Claims Of The Present Application Unpatentable**

Killcommons does not teach, nor suggest, a “second interface unit located at a second location and arranged to store second stored image data of the second patient on the second image

storage unit in response to the second imaging data **and to store second stored identification data on the server located at the first location in response to the second identification data,**” as recited, for example, in claim 1 of the present application. *See* November 1, 2005 Response Under 37 C.F.R. § 1.116 at pages 10-14.

The Examiner concedes that image data is not inherently associated with identification data. *See* September 6, 2005 Office Action at page 2 (“Applicants’ arguments, see Remarks on pages 12-14 regarding *Inherency under section II*, filed on January 24, 2005, have been fully *considered* and are *persuasive*”). The Examiner also concedes that Killcommons does not teach the limitations noted above. *See id.* at page 5, and March 13, 2006 Office Action at page 4 (“Although Killcommons discloses interface unit that is separate for each individual server in it’s (sic) embodiment, Killcommons does not explicitly disclose a first interface unit to store first stored identification data on the server located at the first location in response to the first identification data and a second interface unit to store second stored identification data on the server located at the first location in response to the second identification data.”).

In order to overcome this deficiency, the Examiner cites Heck at column 2, line 44 to column 3, line 50. *See* March 13, 2006 Office Action at page 4. This passage of Heck, however, clearly does not teach or suggest storing image data at one location and identification data at a server. *See* November 1, 2005 Response Under 37 C.F.R. § 1.116 at pages 13-14. As such, the Office Action has not established a *prima facie* case of obviousness with respect to the claims of the present application at least because of the following:

- (1) The Office Action concedes that image data is not inherently associated with identification data (*See* September 6, 2005 Office Action at page 2);

- (2) The Office Action affirmatively states that “Killcommons does not explicitly disclose a first interface unit to store first stored identification data on the server located at the first location in response to the first identification data and a second interface unit to store second stored identification data on the server located at the first location in response to the second identification data” (*See id.* at page 6, and March 13, 2006 Office Action at page 4); and
- (3) The cited passage of Heck that the Office Action relies upon clearly does not teach or suggest the limitations noted above.

Thus, at least for these reasons, the proposed combination of Killcommons and Heck does not render the claims of the present application unpatentable.

## **II. The Proposed Combination Of Killcommons And Heck Does Not Render Claims 17-20 Unpatentable**

As noted above, the March 13, 2006 Office Action is essentially the same as the previous final rejection. *Compare* September 6, 2005 Office Action with March 13, 2006 Office Action. *See also* March 13, 2006 Office Action at page 2 (“... a non-final action is being mailed out with the same rejection.”). The Applicants respectfully maintain that the Examiner has not established a *prima facie* case of obviousness with respect to claims 17-20 because the cited references do not teach or suggest the relevant limitations and the **Office Action does not even attempt to cite anything in the art of record relevant to at least some of the recited limitations.** *See* November 1, 2005 Response Under 37 C.F.R. §1.116 at pages 14-15. Thus, the Applicants respectfully request reconsideration of these claim rejections.

## **III. Conclusion**

In view of the foregoing, it is respectfully submitted that the pending claims of the present application define allowable subject matter. The Applicants respectfully request reconsideration of the claim rejections. **In particular, the Applicants respectfully request that the Panel allow the**

pending claims of the present application, which has been pending for over six years (the present application was filed December 21, 1999).

#### IV. Fees

Pursuant to MPEP § 1207.04, no fee is believed due with respect to this Pre Appeal Brief Conference and the Notice of Appeal, because a Notice of Appeal was previously filed. See November 30, 2005 Notice of Appeal. Please charge any fees, including the fee for the Notice of Appeal, or credit overpayment to Applicants' Deposit Account 07-0845.

Respectfully submitted,

Date: April 11, 2006

By: 

Joseph M. Butscher  
Reg. No. 48,326  
Attorney for Applicants

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500 West Madison Street, 34th Floor  
Chicago, Illinois 60661  
Telephone: (312) 775-8000  
Facsimile: (312) 775 - 8100